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PCT LEGAL ADMINISTRATION

In re Application of KORNERUP et al :
U.S. Application No.: 10/594,048 :
PCT Application No.: PCT/DK2005/000189 : **COMMUNICATION**
Int. Filing Date: 21 March 2005 :
Priority Date Claimed: 26 March 2004 :
Attorney Docket No.: 12706-44 :
For: INFUSION SET :

This application is before the Office of PCT Legal Administration for consideration of issues arising under 35 U.S.C. 371.

BACKGROUND

On 21 March 2005, applicant filed international application PCT/DK2005/000189, which claimed priority of an earlier United States and Denmark application filed 26 March 2004. A copy of the international application was communicated to the USPTO from the International Bureau on 06 October 2005. The thirty-month period for paying the basic national fee in the United States expired on 26 September 2006.

On 25 September 2006, applicant filed purported national stage papers in the United States Designated/Elected Office (DO/EO/US). The submission was accompanied by, *inter alia*, a national stage transmittal letter (Form PTO-1390) and a preliminary amendment.

On 16 May 2007, the DO/EO/US mailed a Notification of Missing Requirements Under 35 U.S.C. 371 (Form PCT/DO/EO/905).

On 20 February 2008, the DO/EO/US mailed a Notice of Acceptance of Application Under 35 U.S.C. 371 (Form PCT/DO/EO/903).

DISCUSSION

MPEP 1893.03(a) states in relevant part,

Applicant's initially deposited application must be clearly identified as a submission to enter the national stage under 35 U.S.C. 371. See 37 CFR 1.495(g). Otherwise, unless the submission is clearly identified as a submission pursuant to 35 U.S.C. 154(d)(4) for the purpose of obtaining provisional rights,

the application will be treated as an application filed under 35 U.S.C. 111(a). See 37 CFR 1.417. . . .Also, if there are any conflicting instructions as to whether the filing is under 35 U.S.C. 111(a) or 35 U.S.C. 371, the application will be accepted as filed under 35 U.S.C. 111(a). A conflicting instruction will be present, for example, where applicant includes in the initial submission under 35 U.S.C. 371, a "Utility Patent Application Transmittal" (Form PTO/SB/05) or includes a benefit claim under 35 U.S.C. 120 to the international application. (Emphasis added.)

In the present case, the papers submitted on 25 September 2006 included an amendment to the specification which contained a benefit claim under 35 U.S.C. 120 to the international application. Such benefit claim was a conflicting instruction which was inconsistent with and contradicted any stated desire to enter the national phase under 35 U.S.C. 371. In accordance with MPEP 1893.03(a), the 25 September 2006 submission should have been treated as a filing under 35 U.S.C. 111(a).

CONCLUSION

For the reasons above, the Notification of Missing Requirements Under 35 U.S.C. 371 (Form PCT/DO/EO/905) mailed 16 May 2007 and the Notice of Acceptance of Application Under 35 U.S.C. 371 (Form PCT/DO/EO/903) mailed 20 February 2008 are hereby VACATED.

This application is being forwarded to the Office of Patent Application Processing for treatment of the application as a filing under 35 U.S.C. 111(a).



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